

REMARKS

I. Introduction

In response to the pending Office Action, Applicants have amended claims 1, 15 and 21 in order to further clarify the subject matter of the present invention. Support for the amendment to claim 1 and 15 may be found, for example, in original claim 2 and in Figs. 2, 4 and 8 of the drawings. No new matter has been added. In addition, claims 2, 16 and 17 have been cancelled, without prejudice.

For the reasons set forth below, Applicants respectfully submit that all pending claims as currently amended are patentable over the cited prior art.

II. The Rejection of Claims 1-6 And 9 Under 35 U.S.C. 102 and 103

Claims 1-6 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by or under 35 U.S.C. § 103(a) as being unpatentable over Arrington et al. (USP No. 6,586,683). Applicants respectfully submit that Arrington fails to anticipate or to render the pending claim obvious for at least the following reasons.

With regard to the present invention, amended claim 1 recites an electronic component comprising: a conductive pattern provided on an insulating substrate; a metal film formed by a plating method on a surface of the conductive pattern; and a metal oxide layer formed by oxidizing the metal film and disposed on the surface of the conductive pattern, wherein the metal oxide layer is formed on a portion of the substrate between electrodes of the pattern on the substrate.

It is admitted that Arrington fails to disclose a copper oxide layer coated between the electrode pads. However, the Examiner takes the position that the prior art has had the copper oxide coating on the substrate surface removed or purposely not coated onto the substrate

surface. It is also admitted that the prior art fails to teach a metal oxide layer formed by oxidizing the metal film, but takes the position that the claimed metal oxide layer is the final product of the metal film and that Arrington's copper oxide layer is the final product of the present invention.

This is not, and has never been a proper standard for rejecting claims. The Examiner is not at liberty to allege a property or limitation of a cited prior art reference merely because she wishes it to be. There has been no suggestion or rationale provide by the Examiner to take the above mentioned position. Moreover, Applicants submit that it is not known to those skilled in the art how a film such as that disclosed in Figs. 5 or 6 of Arrington could be readily removed, as suggested by the Examiner.

Nor are the Examiner's positions supported by any evidence in the prior art. In fact, as stated above, the Office Action admits that Arrington is silent with respect to a metal oxide layer is formed on a portion of the substrate between electrodes of the pattern on the substrate.

As is well known, anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently in a prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986). Also, in order to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA1974). As Arrington, at a minimum, fails to teach or suggest an electronic component comprising a metal oxide layer formed on a portion of the substrate between electrodes of the pattern on the substrate, it is submitted that Arrington does not anticipate, nor render obvious, amended claim 1 or any pending claims dependent thereon.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

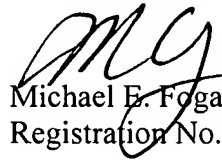
IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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